(12)

Office - Supreme Court, U. S.
FILED
JUL 15 1943
CHARLES ELMORE CROPLEY
CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1943.

No. 169

THE I. T. S. COMPANY,
Petitioner,

v.

SEIBERLING RUBBER COMPANY,
and
THE SEIBERLING RUBBER COMPANY,
Respondents.

PETITION FOR A WRIT OF CERTIORARI
To the United States Circuit Court of Appeals
For the Sixth Circuit, and
BRIEF IN SUPPORT OF PETITION.

F. O. Richey,
H. F. McNenny,
J. D. Douglass,
Counsel for Petitioner.

Richey & Watts,
1150 Union Commerce Bldg.,
Cleveland, Ohio,
Of Counsel.

The Gates Legal Publishing Co., Cleveland, Ohio—Main 5647

INDEX.

PETITION FOR A WRIT OF CERTIORARI..... 1

(A) Summary Statement of the Matter Involved.... 2

(B) Reasons Relied Upon for the Allowance of the Writ 5

BRIEF IN SUPPORT OF PETITION..... 9

I. The Opinions of the Courts Below..... 9

II. Jurisdiction 9

III. Summary of Argument..... 10

IV. Argument 11

Point A 11

There is at Present Diversity of Decisions Between the Courts of Appeals (in the 7th and 2nd Circuits for Example) About the Use of "Objective" or the "Subjective" Tests 16

There is Diversity of Decision Among the Courts of Appeals Below as to What Standard of Invention This Court Has Set or Desires Shall Be Set..... 18

The District Court Decided the Case "Objectively" in Accordance with the Recommendation of the Commission..... 19

The Court of Appeals Decided the Question "Subjectively" or Contrary to the Recommendation of the Commission..... 21

Point B 29

V. Conclusion 31

TABLE OF AUTHORITIES.

Cases.

Del Pozo v. Wilson, 269 U. S. 82..... 27

Duplate v. Triplex, 298 U. S. 448..... 10

Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126 10

Expanded Metal v. Bradford, 214 U. S. 366..... 28

I. T. S. v. Essex, 272 U. S. 429..... 27

Kirsch v. Gould, 6 Fed. (2) 793..... 17

Loom Co. v. Higgins, 105 U. S. 580..... 28

Marconi case, 11 L. W. 4535.....21, 25, 26, 28

Muncie Gear Works v. Outboard Marine & Mfg. Co., 315 U. S. 759..... 10

Paramount Publix v. Tri-Ergon, 294 U. S. 464..... 10

Temco v. Apco, 275 U. S. 319..... 28

U. S. Gypsum v. Consolidated, 130 Fed. (2) 888..... 18

Wahl Clipper Corporation v. Andes Clipper Co., et al., 66 Fed. (2) 162..... 17

Statutes.

28 U. S. C. 41 (7)..... 9

28 U. S. C. 347 (Sec. 240 (a) of the Judicial Code as amended by the Act of February 13, 1925)..... 9

In the Supreme Court of the United States

OCTOBER TERM, 1943.

No. .....

THE I. T. S. COMPANY,
Petitioner,

v.

SEIBERLING RUBBER COMPANY,
and
THE SEIBERLING RUBBER COMPANY,
Respondents.

PETITION FOR A WRIT OF CERTIORARI
To the United States Circuit Court of Appeals
For the Sixth Circuit.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, The I. T. S. Company, respectfully prays that a writ of certiorari issue to review a judgment of the United States Circuit Court of Appeals for the Sixth Circuit, entered April 12, 1943 (re-hearing denied June 2, 1943) in the above entitled cause.

The transcript of the record, including the proceedings in the Circuit Court of Appeals, has been filed herein pursuant to Rule 38.

(A)

SUMMARY STATEMENT OF THE MATTER INVOLVED.

In this suit by petitioner for infringement of a patent relating to an invention in the shoemaker's art, infringement is found by duplication, by both the District Court and the Court of Appeals. No anticipation is found by either Court. The sole question remaining is the question of mechanical skill and invention. The District Court determined this question *objectively* by the nature of the contribution to the advancement of the art, and found invention present; the Court of Appeals determined the question *subjectively*, holding that invention was absent and reversing the District Court. Furthermore, the Court of Appeals determined the question subjectively on considerations relating to an art alien to the art to which the invention relates, without evidence on the subject, and in the face of objection to and exclusion of evidence on the subject in the District Court.

The evidence upon which the District Court found the presence of invention on the *objective* tests included evidence of long standing want and need for the invention; many prior efforts and failures by those skilled in the art to which the invention relates to solve the problem solved by the patentee; public adoption; commercial success; a new mode of operation; achievement of new and useful results, and the achievement of old results in a better way, all of which had long been desired; and duplication of the invention by respondent and the entire industry. Although the Court of Appeals recognized the presence of this evidence and these factors on the objective test, and the fact that the District Court had determined the question of invention and mechanical skill objectively, the Court of Appeals reversed the finding notwithstanding the evidence and determined it by the subjective test, holding that in the opinion of the Court of Appeals the invention was "obvious" to those working in the rubber industry, an

industry alien to the shoemaker's industry. The Court of Appeals did not find that the invention was obvious to those skilled in the shoemaker's art.

Plaintiff proffered evidence to the effect that the invention was not obvious to those skilled in the rubber manufacturer's art, but such evidence was objected to and excluded (R. p. 57).

On December 12, 1941, the President of the United States issued an Executive Order establishing the National Patent Planning Commission "to conduct a comprehensive survey and study of the American patent system," to report upon its accomplishments, past, present, and prospective, upon its value, and to make recommendations to improve upon the same and to obviate "obstructions" to the performance of its intended functions. The Commission was appointed and made extensive investigations, reporting in June, 1943* that the American patent system had been most valuable to the people of the United States, was still valuable, and should be continued. The Commission made certain recommendations for modifying the system and pointed out that one of the "obstructions" to the proper operation of the system was the confusion and babel among the Courts on the question of invention and mechanical skill, recommending that this question "be determined *objectively* by the nature of the contribution to the advancement of the art," and that there be a declaration of policy to that effect, going so far as to recommend that if this could not be done otherwise, Congress might pass a law so legislating. We are informed that this report has been approved by President Roosevelt. (We will discuss these matters more in detail in the argument.)

As this report was handed down in June, 1943, the instant case is the first case brought to this Court since

---

* Published in Advance Sheets, U. S. Pat. Q., Vol. 57, Special Edition, June 19, 1943.

the report was handed down presenting this question to this Court on a diversity of decisions on the subject between the District Court and the Court of Appeals, where the District Court decided the question "*objectively*" by fact findings on the evidence on the basis recommended by the Commission, and was reversed by the Court of Appeals, who decided it "*subjectively,*" without regard to the evidence as the facts found, on the basis condemned by the Commission. Manifestly, there will be no need of a law of Congress on the subject if this Court would determine the question in the instant case in conformity with the recommendations of the Commission by affirming the District Court and overruling the Court of Appeals, and thereby interpreting the existing laws in such a way as to make it unnecessary to amend or supplement the law, all of which is invited by the Commission.

There is, therefore, diversity of decision between the Court of Appeals in the Sixth Circuit and the District Court in this case on a question made of great public interest by the President's Commission.

It is manifestly a matter of far-reaching importance from the standpoint of the public interest to determine whether the question of invention and mechanical skill is to be determined "*objectively,*" as the National Patent Planning Commission has recommended, or "*subjectively,*" contrary to their recommendations. It is also of great public interest to know if it is going to be necessary for Congress to pass a law on this subject, and if the public must wait until Congress can pass such a law to obtain the benefits of such a policy as the Commission recommends.

It is a matter of great public interest to know whether the test for mechanical skill and invention is the same in all arts. In the particular instance—whether the tests for mechanical skill and invention in the shoemaking art is the same as that in the rubber manufacture art. It is also of great public interest to know if a patent can be held

invalid on the theory that the invention is obvious in an art to which the invention does not relate when it is not pleaded and when the evidence on the subject has been excluded, and whether or not that question is to be determined without the benefit of evidence on the subject.

(B)

REASONS RELIED UPON FOR THE ALLOWANCE OF THE WRIT.

(1) There is diversity of decision between the Courts below on the following questions:

(a) The District Court decided the question of invention and mechanical skill "objectively" as the National Patent Planning Commission recommends, and the Court of Appeals determined the question "subjectively," which the said Commission condemns.

(b) Where an invention relates to the shoemaker art, may the question of mechanical skill and invention be determined and gauged by what is obvious or unobvious in the rubber manufacturer's art? The District Court decided the question on the basis of the art to which the invention relates; the Court of Appeals decided it on the basis of an alien art.

(c) Since the act was not within the ruck or skill of those in the shoemaker's art, it is immaterial whether or not it was obvious to those skilled in the rubber manufacturer's art. The District Court so ruled in excluding, at the instance of respondent, evidence as to the unobviousness of the invention in the rubber manufacturer's art; the Court of Appeals held the contrary without remanding or giving petitioner an opportunity to put in the excluded evidence.

(2) It is of great public interest and importance that this Court should dispel the confusion that exists and settle the following questions:

(a) The question of invention and mechanical skill should be determined "objectively," as the District Judge did, and not "subjectively," as the Court of Appeals did, and this Court should declare a policy to that effect so that there will be no need that Congress should pass a law to that effect as the National Patent Planning Commission recommends.

(b) May that which is not within the skill or the ruck of those skilled in the art to which it relates, and which constitutes invention in that art, be held to be non-inventive because it may be thought "subjectively" to be obvious to those in other arts? In other words, are the same tests to be applied in all the arts? Is the test the same for the cobbler, the rubber manufacturer, the chemist, the electrical engineers, and all others?

(c) Is it proper, when evidence on the fact question of the alleged obviousness in the alien art has been objected to by defendant and excluded by the trial Court, for the reviewing Court to hold the inventor's act obvious in the alien art in the absence of the excluded evidence?

(d) Is it proper to hold the act of the inventor within the skill of the alien art when that allegation has not been pleaded or made an issue in the cause?

(e) The case should be remanded and reopened to admit the excluded evidence on the subject if the question is to be determined on the basis of the alien art.

(3) There is diversity of decision between the various Courts of Appeals, some holding to the decision of the

question of patentable invention "objectively," and some "subjectively."

(4) There is diversity of decision between the Courts of Appeals on the question of the standard of invention which this Court has established or desires to establish.

Respectfully submitted,

F. O. RICHEY,

H. F. MCNENNY,

J. D. DOUGLASS,

Counsel for Petitioner.

RICHEY & WATTS,

Of Counsel.